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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,694

Applicant(s)

LEVY ET AL.

Examiner

George C. Neurauter, Jr.

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claims 1-16 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 20 August 2008 have been fully considered but they are not persuasive.

First, it is apparent from the Applicant's response that the Applicant has failed to fully consider the previous Office Action. Throughout the Applicant's response, the Applicant alleges that the cited references, which include the Applicant's admitted prior art, fail to teach a "virtual circuit" or setting up a "virtual circuit". The Examiner sufficiently explained the significance of the Session Initiation Protocol or "SIP" in the previous Office Action. It is clear from all of the cited and the pertinent references in the PTO-892 form included with the previous Office Action and even from the Applicant's own disclosure that the SIP is well-known and used in the art to set up and initiate virtual circuit links in the broadest reasonable interpretation of a "virtual circuit" as described in the specification. Both the Applicant's admitted prior art and "DAN" disclosed SIP and/or the use of SIP and the Examiner fully explained in the previous Office Action how the combined teachings of these references teach the claimed invention. The Applicant's arguments regarding "virtual circuits" are unfounded by the failure by the Applicant to controvert the Office Action by providing any other evidence that disproves that SIP and its use of links that are known to be "virtual circuits" was known in any other context that differs from the claimed invention, particularly the

Applicant's definition of what a "virtual circuit" is in the context of the specification and the claimed invention, and are deemed unpersuasive in the opinion of the Examiner.

The Examiner has shown a one-to-one correspondence between the claimed invention and the cited references, therefore, the Examiner maintains that the combined teachings of these references do in fact teach and/or suggest the claimed invention and the claims are not in condition for allowance.

Regarding the specification amendment regarding the EP document, the Examiner finds the new information regarding the document to be erroneous. The Examiner cites with this Office Action a listing of all European Patent Office publications on the alleged 8 May 2002 date. There is no listing of any "EP1204246" document for the publication date on 8 May 2002. Again, the Examiner requests that the Applicant provide the correct number for this document.

Also, the Examiner notes that the Applicant failed to correct the document number on page 8, line 9. This also must be corrected in order to remove the specification objection.

Specification

The specification is also objected to since the specification at page 7, line 25 lists a prior art document as "EP 1 204 246 A1" and page 8, line 9 lists a prior art document as "EP-A-1 204 246". A search by the Examiner at the European Patent Office revealed no such document by this number. The Applicant is requested to correct the number as shown in the specification and, if possible, provide the prior art document for proper consideration by the Examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art ("AAPA") in view of "Distributed Code Caching for Active Networks" ("DAN").

Regarding claim 1, "AAPA" disclosed an active telecommunications network comprising:

an active node comprising active code reception means and an active code execution environment (see page 2, lines 11-15 and 23-26 of the specification; note that if the active node is able to execute active code, it must have an active code execution environment); and

a signaling control unit (see at least page 1, lines 5-13 of the specification) comprising:

means for receiving a request (5) to set up a virtual circuit between a client terminal and a server terminal; virtual circuit set-up means (see at least page 1, lines 5-24, wherein the signaling control unit may be a SIP proxy, which is known to set up virtual circuits for a communication session between a client and server; see also Applicant's admitted prior art "Session Initiation Protocol", the "standard" described in the specification being "RFC 2543", which has been cited in this Office Action).

Applicant's admitted prior art did not expressly disclose wherein the signaling control unit contains means controlled by the virtual circuit set-up means for sending active code to the active node, however, the Applicant did admit that the prior art disclose wherein active nodes receive active code in response to setting up a virtual

circuit between a client and a server (see at least page 2, lines 23-37 and page 3, lines 1-3)

"DAN" disclosed a unit that sends active code to an active node upon a request to set up a virtual circuit between a server and a client analogous to the situation described in the Applicant's admitted prior art (see at least page 611, left column).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the means for sending active code to an active node within the signaling control unit described in "AAPA" since the combination would provide a system that takes advantage of the active network paradigm as described in both the Applicant's admitted prior art and "DAN" for virtual circuit applications such as those also described in both "AAPA" and "DAN" and one of ordinary skill, based on their analogous disclosures, would have expected the combination to be successful.

Regarding claims 2-4, "AAPA" and "DAN" disclosed a network according to claim 1.

"AAPA" did not expressly disclose a network characterized in that the signaling control unit further comprises an active code library; means for selecting active code in the library, active code compilation means, and means for generating active code on the fly, however, "DAN" did disclose these limitations (see at least page 611, left column, specifically regarding the steps described in Figure 2)

Claims 2-4 are rejected since the motivations regarding the obviousness of claim 1 also applies to claims 2-4.

Regarding claim 5, "AAPA" and "DAN" disclosed a network according to claim 1.

"AAPA" disclosed wherein the network is adapted to use the Internet Protocol (IP). (see at least page 1, lines 14-17)

"DAN" similarly discloses such a limitation (see at least page 610, left column, specifically "...common network layer protocol (typically IP)..."; see also references to the IP protocol throughout the reference)

Regarding claim 6, "AAPA" and "DAN" disclosed a signaling method for use in a telecommunications network according to claim 1.

"AAPA" did not expressly disclose sending an appropriate active code from the signaling control unit to the active node, however, the Applicant did admit that the prior art disclose wherein active nodes receive active code in response to setting up a virtual circuit between a client and a server (see at least page 2, lines 23-37 and page 3, lines 1-3)

"DAN" disclosed a unit that sends an appropriate active code to an active node upon a request to set up a virtual circuit between a server and a client analogous to the situation described in the Applicant's admitted prior art (see at least page 611, left column).

Claim 6 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 6.

Regarding claim 7, "AAPA" and "DAN" disclosed a method according to claim 6.

"AAPA" did not expressly disclose a step prior to the sending step of deciding on a strategy for sending of the appropriate active code by the signaling control unit,

however, "DAN" disclosed that the active code is selected based on the function required before being sent to the active node (see at least page 611, left column).

Claim 7 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 8, "AAPA" and "DAN" disclosed a method according to claim 6.

"AAPA" did not expressly disclose a step prior to the sending step and optionally prior to the strategy decision step of the signaling control unit determining the appropriate active code, however, "DAN" disclosed that the active code is selected based on the function required before being sent to the active node (see at least page 611, left column).

Claim 8 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 9, "AAPA" and "DAN" disclosed a method according to claim 8.

"AAPA" disclosed a step prior to the determination step of negotiation between the terminals and the signaling control unit of the characteristics of a communications session. (see at least page 1, lines 5-24, wherein the signaling control unit may be a SIP proxy, which is known to set up communication sessions including the characteristics for a communication session between a client and server; see also Applicant's admitted prior art "Session Initiation Protocol", the "standard" described in the specification being "RFC 2543", which has been cited in this Office Action).

Regarding claim 10, "AAPA" and "DAN" disclosed a method according to claim 6.

"AAPA" disclosed a step prior to the negotiation step of the signaling control unit receiving the virtual circuit request and setting up the virtual circuit. (see at least page 1, lines 5-24, wherein the signaling control unit may be a SIP proxy, which is known to set up virtual circuits for a communication session between a client and server; see also Applicant's admitted prior art "Session Initiation Protocol", the "standard" described in the specification being "RFC 2543", which has been cited in this Office Action).

Regarding claim 11, "AAPA" and "DAN" disclosed a method according to claim 8.

"AAPA" did not expressly disclose wherein, when the control unit (3) comprises the active code library and selection means, the determination step comprises the selection by the control unit of the appropriate active code in the library, however, "DAN" disclosed that the active code is selected based on the function required before being sent to the active node (see at least page 611, left column).

Claim 11 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 12, "AAPA" and "DAN" disclosed a method according to claim 8.

"AAPA" did not expressly disclose wherein, when the control unit (3) comprises active code generation means, the determination step comprises the generation of the appropriate active code on the fly by the control unit, however, "DAN" did disclose these limitations (see at least page 611, left column, specifically regarding the steps described in Figure 2)

Claim 12 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 13, "AAPA" and "DAN disclosed a network according to claim 1.

"AAPA" and "DAN" did not expressly disclose wherein the means controlled by the virtual circuit set-up means for sending active code to the active node reduces mismatching between stream characteristics required by an application and an instantaneous state of the active telecommunication network.

However, claim scope is not limited by claim language that merely expresses its intended use or result by suggesting or making optional steps but does not require the steps to be performed or by claim language that does not limit a claim to a particular structure. See MPEP 2111.04 and *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include these limitations with the claimed invention because the limitations merely express the intended use of a step or means by suggesting or making optional steps but does not require the steps to be performed, or by claim language that does not limit a claim to a particular structure and that the positively recited steps as shown as disclosed in the cited references encompass the scope of the recited intended result or use of the positively recited subject matter.

Claim 15 is also rejected since this claim recites substantially the same limitations as recited in claim 13.

Regarding claim 14, "AAPA" and "DAN" disclose a network according to claim 1.

"AAPA" disclosed wherein the client terminal transmits a data stream to the server terminal. (see at least page 2, lines 1-7 and 11-15 and page 3, lines 1-3)

Claim 16 is also rejected since this claim recites substantially the same limitations as recited in claim 14.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C. Neurauter, Jr./
Primary Examiner, Art Unit 2443